UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,521	12/14/1999	REINHARD HEINRICH HOHENSEE	BO9-99-013	3912

7590	02/14/2005

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EXAMINER
NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/461,521 ✓	HOHENSEE ET AL.
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _07 September 2004 and 08 September 2004_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2,4-7,9-12,14 and 15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-2, 4-7, 9-12, and 14-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communications: Appeal Brief filed on

09/07/2004 and Amendment After Final filed on 09/08/2004.

Response to Arguments

2.   In view of the Appeal Brief filed on 09/07/2004, PROSECUTION IS HEREBY

REOPENED. A rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

3.   Claims 1-2, 4-7, 9-12, and 14-15 are pending.   Claims 1, 6, and 11 are

independent claims.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, claims 1, 6 and 11 include limitation "comparing an amount of data processing required to convert said unit to device-independent format to a predetermined level of data processing", which was not described in the specification. In the specification on page 10, line 26 – page 11, line 8, it is described in the determination step that if the unit data type is either not complex or not complex, and if it is not complex then data type does not require intensive processing for generation of the device-specific format, and if it is complex then generating and storing device-dependent formats for each selected device in the system. Thus, one skilled in the relevant art at the time the invention was filed would not be able to interpret the details of the specification on page 10, line 26 – page 11, line 8 to the claimed invention such that "comparing an amount of data processing required to convert said unit to device-independent format to a predetermined level of data processing". Appropriate correction is required.

Claim Rejections - 35 USC § 103

6.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

7.   **Claims 1-2, 4-7, 9-12, and 14-15** are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent Number 6,336,124 B1 to Alam et al., issued January 1,

2002, filed July 7, 1999 in view of U.S. Patent Number 5,813,020 to Hohensee et al.,

issued September 22, 1998, U.S. Patent Number 5,767,833 to Vanderwiele et al.,

issued June 16, 1998, and U.S Patent Number 6,590,674 B1 to Orton, issued July 8,

2003, filed September 23, 1999.

8.   Regarding **independent claims 1, 6, and 11**, Alam et al. teach a data

processing system having a CPU, memory, at least one user output device, and a user

input device. (Alam et al., Fig. 2.)

Further, Alam et al. teach a method for retrieving and presenting stored

documents on a plurality of output devices each requiring different presentation

parameters. (Alam et al., Abstract.)

Further, Alam et al. teach parsing a document into one or more objects. (Alam et

al., col. 6, lines 16-18: "Text/image document 518 is output to a document converter 528

which converts text and/or image document 518 to an intermediate format document

530."; col. 6, lines 59-61: "Each group is stored in the intermediate format document as

an intermediate format block.")

Further, Alam et al. inherently teach classifying a plurality of presentation devices inasmuch as they teach that devices can access an index document that will allow them to select an output format suitable for the device (Alam et al., col. 21, lines 54-57); such a selection would not be possible unless devices were classified.

Further, Alam et al. teach receiving a request from a presentation device. (Alam et al., col. 22, lines 34-35.)

Further, Alam et al. teach assembling a document from stored intermediate format blocks, analogous to stored units. (Alam et al., col. 20, lines 25-29.)

Further, Alam et al. teach sending the assembled document to the presentation device. (Alam et al., col. 20, lines 49-51.)

Further, Alam et al. do not teach parsing each object into one or more units. However, Hohensee et al. teach parsing an object into one or more units when the object is a page segment. (Hohensee et al., Fig. 3.) Moreover, one of ordinary skill in the art would have recognized the need to parse an object into one or more units because one of ordinary skill would have known that objects such as pages are frequently comprised one or more units. Therefore, it would have been obvious to one of ordinary skill in the art to parse each object into one or more units.

Further, Alam et al. does not teach for each units, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing; storing said units, requiring less than said predetermined level of data processing to convert to said device-dependent format, in device-independent format and storing said units, requiring more than said predetermined level of data

processing to convert to said device-dependent format, in said device-dependent format

based on the classified plurality of presentation devices. In the same field of endeavor,

Vanderwiele et al. teach a system determines whether the device is a 24 bpp (bit per

pixel element) device, or 8 bpp device, and then the system converts either 24 or 8

device independent bits (DIB) to 24 or 8 device dependent bit (DSB) format before

outputting to storage or to the device in the DSB format (col. 5, line 19 – col. 6, line 12).

Vanderwiele et al. also teach a system that "determines whether [an] image is targeted

for multiple hardware formats or a single hardware format and then provides a

conversion from device independent bits to device dependent bits formats in the case of

the multiple hardware format targeting, or performing image conversion appropriate for

the single device in the case of the single device targeting." (Vanderwiele et al.,

Abstract.) In addition, Orton teaches storing document units in a universal, viewer-

independent format so that files may be viewed in a multitude of applications. (Orton,

col. 2, lines 33-46.) Moreover, one of ordinary skill in the art would have recognized the

benefit of storing units in device independent format requiring less process where

possible, since one of ordinary skill would have recognized that less processing is

desirable. One of ordinary skill in the art would also have recognized the desirability of

storing units in device-dependent format requiring more processing when the target

device was known to be a particular class of device, since this would deliver data to the

device more quickly. Therefore, it would have been obvious to one of ordinary skill in

the art to have implemented the steps of storing units, requiring less processing to

convert to device-dependent format, in device-independent format or storing units,

requiring more processing to convert to device-dependent format, in device-dependent

format.

9.   Regarding **dependent claims 2, 7, and 12,** Alam et al. teach determining a type

of each unit inasmuch as determining a type of intermediate format block, analogous to

units, is inherent in Alam et al.'s teaching of keeping track of and storing different kinds

of intermediate format blocks, such as text, images, and multimedia files. (Alam et al.,

col. 6, line 57 – col. 7, line 1.)

10.   Regarding **dependent claims 4, 9, and 14,** Alam et al. teach determining

acceptable document formats for the connected presentation devices inasmuch as such

a determination would have been inherent in sending an output format "depending upon

the requesting application or output display device" (Alam et al., col. 20, lines 59-60), as

well as the execution of JavaScript to select a suitable output format for the device

(Alam et al., col. 21, lines 54-57); *i.e.,* before a selection of a suitable output format

could be made, it would have been necessary to determine what formats were

acceptable.

Further, Alam et al. do not explicitly teach classifying devices according to

device-dependent characteristics. However, one of ordinary skill in the art would have

known that it was most efficient to classify devices according to device-dependent

characteristics because one of ordinary skill would have recognized that classifying

devices according to device-dependent characteristics would have resulted in the

minimum number of classifications possible, and that devices with different

characteristics could be classified together as long as the different characteristics were

not device-dependent. Therefore, it would have been obvious to one of ordinary skill in the art to classify devices according to device-dependent characteristics.

11.   Regarding **dependent claims 5, 10, and 15**, Alam et al. do not teach determining whether the peripheral device is known or unknown. However, inasmuch as Alam et al. teach sending an output format "depending upon the requesting application or output display device" (Alam et al., col. 20, lines 59-60), one of ordinary skill in the art would have recognized that it would have been necessary to determine whether the peripheral device was known or unknown before selecting an output to be sent to it, because one of ordinary skill would have seen that it would not have been possible to send device-dependent output to an unknown device. Therefore, it would have been obvious to one of ordinary skill in the art to implement the recited claim limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOSEPH FEILD
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